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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,070

03/30/2004

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EXAMINER

KEMMERLE III, RUSSELL J

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,070	Applicant(s) YAMAGUCHI ET AL.	
	Examiner RUSSELL J. KEMMERLE III	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 10-16,23-25,31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,17-22 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>30 March, 2004; 9 August 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I claims 1-9, 17-22 and 26-30 in the reply filed on 10 April 2008 is acknowledged. The traversal is on the ground(s) that the subject matter of all claims 1-32 is sufficiently related that a thorough search for the subject matter of any one group would encompass a search for the subject matter of the remaining claims. As evidence of this, Applicant points out that groups I and II are classified in the same class, although group III is ignored in this argument. This is not found persuasive because the fact that groups are classified in the same class does not mean that a thorough search for the subject matter of one group would encompass a thorough search for the other groups. A class contains hundreds of subclasses where the search is defined, and as pointed out in the restriction requirement, groups I and II would be classified in different subclasses of class 264. In addition, a proper search includes other methods such as keyword searching which would be different for groups I and II based on the different subject matter. Therefore, it would be a serious burden to search and examine all of claims 1-32.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

It is noted that the specification appears to be a direct translation from a foreign language, and Applicant's assistance is requested in ensuring that the specification (including the claims) is in proper idiomatic English.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 17-22 and 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the gripping portion be disposed "at a position so as to orient in a direction crossing the constant extrusion direction" (last two lines). It is unclear what is meant by this phrase as it is not explained how the orientation is determined or what a "direction crossing a direction" means.

Similarly, claims 17 and 26 recite disposing the gripping portion in a direction crossing a supply direction, it is not clear what this means and where the gripping portion should be placed.

Claim 3 refers to the heat distortion temperature of the resin, it is unclear what this temperature is or how it is determined based on the specification.

Claims 4, 18 and 26 recite the limitation "the other part". There is insufficient antecedent basis for this limitation in the claim and it is unclear what this other part of the member means.

Claims 20, 28 and 29 recite performing an operation in accordance with a predetermined program. It is unclear what this program is, how it is determined and how the recited operations are carried out in accordance with it.

The remaining claims are rejected under 35 U.S.C. 112, second paragraph, based on their dependence from one of the claims discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Otagawa (US Patent 4,982,486).

Otagawa discloses a method of making a resin molding for use on vehicles. Otagawa discloses that the process involves extruding a resin body through known techniques (including the use of a sizer), followed by allowing the resin to at least partially harden, and performing an axial bend (Col 3 line 42 – Col 4 line 20).

Referring to claim 2, the molding would have to be bent while at an elevated temperature in order for the bending to result in a final piece having such a bend, as is known to those in the art. If this were done using residual heat from the molding process (that is, while it is cooling, as appears to be the case in Otagawa since it is not stated that the molding is cooled and reheated during the recited processing steps) this

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would result in the temperature inside being higher than the temperature on the surface (since the molding would cool from the outside inward).

Referring to claim 4, the bent molding of Otagawa has a radius of curvature that is different at different points of the molding (as shown in Fig 2).

Referring to claim 6, Otagawa discloses that after bending the body is water cooled during sizing (i.e., compulsory cooled) (Col 4 lines 50-55).

Referring to claim 9, while the specific action performed by the bender in Otagawa is not disclosed, it would have necessarily had to have performed at least two of the steps recited in claim 9 to achieve the product shown in Fig 2. This is because if at least two of these steps are not performed the piece depicted in the figure could not have been made having such a shape while maintaining the constant angle of the cross section as is shown.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8, 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otagawa.

Otagawa is relied upon as discussed above.

Referring to claim 8, Otagawa discloses that the molding be cut to length then bent. However, it would have been obvious to one of ordinary skill in the art that the selection of any order of these steps could have been effective, absent a showing of unexpected results. This would have been obvious because it appears that each step performs the same function in Otagawa and in the current invention, and that the performance of that step is not dependant on the other step being performed first. Specifically the bent body could be cut to size in the same manner that an uncut body could be, and a cut body could be bent in the same way as an uncut body. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of

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performing process steps is prima facie obvious in the absence of new or unexpected results).

Referring to claim 17, Otagawa discloses that a first body be formed (stainless steel web) followed by passing it through an extrusion die, the resulting body is then bent. However, it would have been obvious to one of ordinary skill in the art that the selection of any order of these steps could have been effective, absent a showing of unexpected results. This would have been obvious because it appears that each step performs the same function in Otagawa and in the current invention, and that the performance of that step is not dependant on the other step being performed first. Specifically the bent stainless steel sheet could be passed through the extrusion die to have a resin part formed on it in the same manner that an uncut sheet could be, and a stainless steel sheet with the resin already molded to it could be bent in the same way as a sheet without the resin molded on to it. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results).

Referring to claims 18, 19 and 20, these limitations have been addressed above in the rejections under 35 USC 102(b) of claims 4, 9 and 6 respectively, and are reasserted here.

Referring to claim 22, Otagawa discloses that the first member be a stainless steel (metal) strip that has been roll-formed (Col 3 lines 42-44).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUSSELL J. KEMMERLE III whose telephone number is (571)272-6509. The examiner can normally be reached on Monday through Thursday, 7:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven P. Griffin/
Supervisory Patent Examiner, Art
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/R. J. K./
Examiner, Art Unit 1791